

REMARKS/ARGUMENTS

Specification

As stated in item 2 of the Office Action, the substitute specification filed 04/19/2004 was not entered because it did not conform to 37 CFR 1.125(b) and (c) because, in the Examiner's opinion, the amendment was not supported by the original disclosure in that the term "automatically" could not be found in the specification.

The amendments to the specification requested in the previous response have been re-submitted herewith omitting the term "automatically."

Claims

The Examiner rejected claims 1-30. By this amendment, claims 1, 17, and 26 have been amended to delete the word "automatically." New claim 31 has been added directed to the instantaneous enablement of the one-click translation component for display to the user simultaneously with at least part of the communication. Basis for this amendment may be found, for example, on page 9, lines 14-17.

Therefore, claims 1-31 are pending in the application.

Claim Rejections – 35 USC § 112

Claims 1-30 were rejected as failing to comply with the written description requirement in that independent claims 1, 17 and 26 and the remaining claims dependent thereon included the limitation "*automatically* displaying simultaneously to a user," but the term "automatically" could not be found in the specification. Claims 1, 17, and 26 have been amended to delete the word "automatically." Applicant requests withdrawal of the rejection under Section 112.

Claim Rejections – 35 USC §103(a)

Claims 1-3, 6-9, 12, 16-22, 25-26 and 28 were rejected under 35 U.S.C. 103(a) as unpatentable over Chong et al. (US 5,497,319) in view of Kato (Derwent Accession No. 2000-004258, JP 11-282848).

Claims 4 and 5 were rejected under 35 U.S.C. 103(a) as being unpatentable over Chong et al. in view of Kato and further in view of Kobayakawa et al. (US 6,119,078).

Claims 10 and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Chong et al. in view of Kato and further in view of Beurket et al. (US 6,360,273).

Claims 11, 23 and 27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Chong et al. in view of Kato and further in view of Robinson (US 6,323,310).

Claims 13-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Chong et al. in view of Kato and further in view of Roy (US 6,600,725).

Claim 29 was rejected under 35 U.S.C. 103(a) as being unpatentable over Chong et al. in view of Kato and further in view of Douglass et al. (US 6,021,426).

Claim 29 was rejected under 35 U.S.C. 103(a) as being unpatentable over Chong et al. in view of Kato and further in view of Hall et al. (US 6,026,375).

Hence, all of the Examiner's claim rejections are based on the modification of Chong by Kato.

On page 4 of the Office Action, the Examiner acknowledges that Chong does not teach submitting a request for a translation by clicking once on the translation component, the translation component comprising an object identified as effecting a translation of the electronic communication. However, on page 5 of the Office Action, the Examiner states that Kato teaches a one-click and drag operation for requesting translation of a selected communication. The Examiner further asserts that it would have been obvious for the skilled person to combine the teachings of Chong and Kato and that such a combination would result in the invention as claimed in claim 1, thus rendering claim 1 obvious.

To confirm the teachings of Kato, a user: 1) places the cursor on the screen adjacent the text to be translated; 2) presses the mouse button; 3) (with the mouse button still pressed) drags the cursor over the text and highlights the text to be translated; 4) depresses or releases the mouse button; 5) the translated text appears in the same location of the screen and instead of the original text. This also appears to be the Examiner's understanding of the teachings of Kato.

The Applicant agrees with the Examiner in that Kato teaches a *one-click and drag* operation to highlight the text to be translated and to effect translation of the highlighted text.

However, it is clear that Kato teaches that the user must first highlight the text to be translated to create the highlighted area. It is the highlighted area that the Examiner asserts on page 5 of the Office Action to be the object identified as effecting a translation.

On this basis, Kato does not, therefore, teach the *user clicking the one-click translation component to request translation of the electronic communication*, as specified in claim 1 and in the other independent claims, 17 and 26, of the present application. In contrast, Kato teaches that the release of the mouse button causes the translation to be requested and the translated text to appear.

In Kato, once the text has been highlighted, thus creating the object identified as effecting a translation, the user cannot then click on the object identified as effecting a translation because the mouse button is already pressed. Releasing the button effects the translation, but doing so causes the object identified as effecting a translation to disappear and the translated text to appear in its place.

It is clearly shown in the Drawings that the one-click translation component of the present invention is clearly visible at all times - before, during and after the electronic communication is translated. This is sharply in contrast with Kato, which teaches that the translation component, or object identified as effecting a translation, does not exist until the text to be translated is selected by the user and does not exist after the text is translated.

It is clear from the language employed in the claims regarding the simultaneous display of at least part of the electronic communication and the one-click translation component, that these are separate integers. Hence, the one-click translation component of the present invention is clearly visible before, during and after the electronic communication is translated.

Therefore, if the skilled person would have been motivated to modify the teachings of Chong by those of Kato, such a modification could not have resulted in the method as claimed in independent claim 1, nor the system and apparatus of independent claims 17 and 26 respectively.

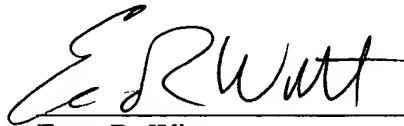
None of the prior art of record, whether taken alone or in combination, discloses, suggests or renders obvious the present invention as claimed. Hence, independent claims 1, 17, and 26, and the claims dependent thereon are both novel and non-obvious.

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Amdt. dated August 5, 2004
Reply to Office Action of May 10, 2004

Conclusion

In light of the above amendments and remarks, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "E R Witt", written over a horizontal line.

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